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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUHJI YAMASHITA, HIROBUMI TOYSHIMA, and
YASUhide NIIMURA

Appeal 2009-010982
Application 10/673,812¹
Technology Center 2400

Before MAHSHID D. SAADAT, MARC S. HOFF, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of
claims 1-9. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ The real party in interest is IBM Corporation.

Appellants' invention concerns a relay processing apparatus for relaying communications between a process for a control program that generates control commands for a terminal and a process for an HTTP server program that returns to the terminal a command constituting an HTTP response to a HTTP request received from the terminal. A terminal request processor initiates the process performed by the control program upon reception of a function call from the HTTP server program. A control request processor receives from the control program a command corresponding to a function call, and transmits to the terminal request processor a notification that the command has been received. The terminal request processor is permitted to return processing to the HTTP server program, which is then permitted to return the command included in the HTTP response issued for the HTTP request (Spec. 2-3).

Claim 1 is exemplary of the claims on appeal:

1. A relay processing apparatus (200) for relaying communications between a control program (250) that generates control commands for a terminal (100) and a process for an HTTP server program (210) that returns to said terminal a command constituting an HTTP response to a HTTP request received from said terminal, comprising:
a terminal request processor (220) for initiating said control program (250) upon the reception of a function call from said HTTP server program (210) that initially received said HTTP request from the terminal; and
a control request processor (230) for receiving from said control program (250) a first command generated as a response to the function call, and for transmitting to said terminal request processor a notification (S350) that said first command has been received, means in the terminal request processor responsive to the reception notification, for returning the first command to said HTTP server program (S380), and means in the HTTP server program for returning said command (S390) to the terminal in said HTTP response issued for said HTTP request.

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Kanemaki	US 2002/0138761 A1	Sep. 26, 2002
Perlman	US 6,510,523 B1	Jan. 21 2003
Devine	US 6,598,167 B2	Jul. 22, 2003
Hoffmann	US 6,728,769 B1	Apr. 27, 2004
Chakraborty	US 2004/0107282 A1	Jun. 3, 2004

Vilaghy et al., E-business Cookbook for z/OS Volume 1: Technology Introduction, (July, 2002), <http://www.ibm.com/redbooks>

Claims 1, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vilaghy.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Vilaghy in view of Hoffman.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vilaghy in view of Chakraborty.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Vilaghy in view of Devine.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Vilaghy in view of Perlman.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Vilaghy in view of Perlman and Kanemaki.

Throughout this decision, we make reference to the Appeal Brief (“App. Br.,” filed December 8, 2008), the Reply Brief (“Reply Br.,” May 5, 2009), and the Examiner’s Answer (“Ans.,” mailed March 5, 2009) for their respective details.

ISSUES

Appellants argue, *inter alia*, that the Examiner failed to comply with the requirements of *Graham v. John Deere Co.*, 383 U.S. 1 (1966). That is, the Examiner failed to identify the limitations Vilaghy fails to teach, and to precisely describe the alleged modification to the teachings of Vilaghy (App. Br. 10-12). Appellants further argue that Vilaghy, as interpreted by the Examiner, fails to teach a control request processor transmitting to the terminal request processor a notification that a first command has been received (Reply Br. 5).

Appellants' contentions and the Examiner's findings, present us with the following issues:

1. Does the Examiner's rejection identify the limitations that Vilaghy fails to teach, and describe the proposed modification to Vilaghy, in accordance with the requirements of *Graham v. John Deere Co.*?
2. Does Vilaghy teach a control request processor that transmits to the terminal request processor a notification that a first command has been received?

PRINCIPLES OF LAW

Section 103(a) forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including; (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in

the art, and (4) wherein evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 550 U.S. at 407, (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

ANALYSIS

CLAIMS 1, 8, AND 9

Claims 1, 8, and 9 each recite a terminal request processor for initiating a control program upon the receipt of a function call from an HTTP server program; a control request processor for receiving from the control program, a first command generated as a response to the function call, and for transmitting to the terminal request processor, a notification that the first command has been received.

The Examiner finds that various portions of Vilaghy teach elements that correspond to the elements of the claims (Ans. 4-6). We agree with Appellants, however, that the Examiner has failed to ascertain the differences between the prior art and the claims at issue, or to articulate the proposed modification to the reference, as *Graham v. John Deere Co.*, requires (App. Br. 12).

The Examiner admits, citing a first portion of Vilaghy, that “the Web component tier fails to disclose an HTTP server receiving an HTTP request or a control request processor for receiving from said control program a first command generated as a response to the function call, and for transmitting to said terminal request processor a notification that said first command has been received” (Ans. 4, citing Vilaghy p. 124). The Examiner then finds that a different portion of Vilaghy discloses “a CICS WebServer Plugin

wherein an HTTP Server receives the HTTP request” (Ans. 4-5, citing Vilaghy p. 154). The Examiner further finds a teaching of “a control request processor for receiving from said control program a first command generated as a response to the function call, and for transmitting said terminal request processor a notification that said first command has been received” (Ans. 5, citing Vilaghy p. 67).

The Examiner then concludes that incorporating a CICS WebServer Plugin with a Web component tier would have been obvious, “for the purpose of a relay processing apparatus wherein an HTTP client can communicate with a back-end application” (Ans. 5-6). The Examiner fails to explain with any particularity, however, what would have motivated the person of ordinary skill in the art to combine these disparate embodiments of Vilaghy, or how such a combination might be accomplished.

Appellants further argue, and we agree, that Vilaghy does not teach that the Enterprise Java Bean (EJB) Container (equated by the Examiner with the claimed control request processor, Ans. 14) transmits to the WebSphere Plugin (equated by the Examiner with the claimed terminal request processor, Ans. 18) a notification that the first command has been received (Reply Br. 5).

Because Vilaghy does not teach or suggest all the limitations of claims 1, 8, and 9, and because the Examiner has failed to satisfy the requirements for establishing obviousness under *Graham v. John Deere Co.*, we conclude that the Examiner erred in rejecting claims 1, 8, and 9 under § 103. We will not sustain the rejection.

CLAIMS 2-7

We have reviewed the further references to Hoffman, Chakraborty, Devine, Perlman, and Kanemaki, and we find that they do not remedy the deficiencies of Vilaghy noted *supra*.

We therefore conclude that the Examiner erred in rejecting claims 2-7 for the same reasons expressed *supra* with respect to claims 1, 8, and 9. We will not sustain the § 103 rejections of claims 2-7.

CONCLUSIONS

1. The Examiner's rejection does not identify the limitations that Vilaghy fails to teach, and does not describe the proposed modification to Vilaghy, in accordance with the requirements of *Graham v. John Deere Co.*

2. Vilaghy does not teach a control request processor that transmits to the terminal request processor a notification that a first command has been received.

ORDER

The Examiner's rejection of claims 1-9 is reversed.

REVERSED

gvw